

REMARKS

Claims 1 through 15 are pending in this application. Claims 5 through 15 stand withdrawn. In response to the Office Action, dated December 19, 2003, claims 1 and 2 have been amended. Care has been taken to avoid the introduction of new matter. Favorable reconsideration of the application in light of the following comments is respectfully solicited.

Paragraph 5 of the Office Action characterizes claim 2 as a "product by process," the claimed subject matter considered drawn to "the final product per se" with no patentable weight attributed to the manner in which it is made. Claim 2 has been amended to clarify the recitation of a semiconductor device, further defining the subject matter of parent claim 1.

Claims 1 through 3 have been rejected under 35 U.S.C. § 102(b) as being anticipated by JP63250148 (Toshio), as presented in paragraphs 7, 9 and 10 of the Office Action. Claims 2 through 4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Toshio, as further set forth at paragraph 12 of the Office Action.

The Office Action reads all claimed elements on the reference on the basis of the English language abstract of this foreign language document and the drawing figures. It is submitted that it is improper for an Office Action to rely on a foreign language reference on which to base the rejections without providing a full English language translation. Attention is directed to three decisions of the Board of Patent Appeals and Interferences, *i.e.*, *Ex Parte Gavin*, 62 USPQ2d 1680 (BPAI 2001); *Ex Parte Bonfils* 64 USPQ2d 1456 (BPAI 2002); and *Ex Parte Jones*, 62 USPQ2d 1206 (BPAI 2001). Each of these decisions holds that it is the examiner's responsibility to obtain translations of foreign language references and to base rejections on the translated text and not an English abstract or summary. See also MPEP § 706.02, which states "[i]f the document is in a language other than English and the examiner seeks to rely on that document, a

translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection." No such translation has been relied upon of record. Applicants are thus left in the unenviable position of having to speculate as to whether there is factual basis to support the rejection of the current claims or any amendments thereof. It is urged, therefore, that if Toshio is again relied upon as a basis for rejection in a future Office Action, a full translation be provided and that Office Action not be made final.

Claim 1 has been rejected further under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 6,373,548 (Kim). Claims 2 through 4 have been rejected further under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Kim.

Independent claim 1 has been amended and now recites, *inter alia*, the following:

said dicing line area comprises first and second registration marks formed in different shots in respective registration mark areas,

a boundary line separates said respective registration mark areas, said boundary line defining a protruded portion and a recessed portion, the protruded portion containing at least one of the registration marks, and

said first and second registration marks each include an auxiliary mark to identify the first and second registration marks.

The recitation of the boundary line defining protruded and recessed portions to include registration marks is supported by Fig. 6 and the corresponding description of the specification, for example, beginning at page 20. It is submitted that neither Toshio nor Kim disclose or suggest a shot boundary between areas formed in different shots that is arranged in a dicing line area to define a protruded portion and a recessed portion, at least one of the registration marks arranged in the protruded portion.

Accordingly, it is submitted that claims 1 through 4 are patentably distinguishable from the prior art. Allowance of the application is respectfully solicited. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Stephen A. Becker
Registration No. 26,527

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 GZR:SAB:lnm:cms
Facsimile: (202) 756-8087
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